

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Serial No.: 09/818,483 Confirmation No.: 3692
Applicant: E. Brian Finkelstein, et al.
Title: NEGOTIATED RIGHT EXCHANGE
Filed: March 27, 2001
Art Unit: 3692
Examiner: S. Meinecke Diaz

Atty. Docket: 00-8201
Customer No. 63710

SUPPLEMENTARY SUMMARY OF INTERVIEW

Mail Stop Amendment
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

This is a supplementary summary of the interview of January 22, 2009.

As background, recall that the PTO's advises applicants as follows, MPEP § 714.12:

Many of the difficulties encountered in the prosecution of patent applications .. may be alleviated if each applicant includes, at the time of filing or no later than the first reply, claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.

Since April 2007 – over three years – Applicant has diligently sought to advance the application by carrying out the PTO's own advice. Since the earliest possible time, Applicant has sought to present “claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept.”

In the January 2009 interview, the understanding of all participants was that the most important step in getting examination back on track was to get claims entered that meet the statutory requirements for patentability, so that prosecution can advance toward an efficient resolution.

During the January interview, after Examiner Maguire, Examiner Abdi, and Attorney Boundy explored several alternatives, *SPE Abdi* suggested the following approach:

1. SPE Abdi suggested that Applicant first file a paper reinstating claim 14 (which of course has to have a new claim number)
2. SPE Abdi suggested that Applicant then immediately file a second amendment to amend the claims using strikeout-and-underline, to make accomplish two goals:
 - (a) make clear the relationship between claim 14 (as opposed to the approaches taken in previous papers that Examiner Maguire refused to enter), and the closest claim in the new claim set (then claim 190, now claim 266)
 - (b) get all “claims varying from the broadest to which he or she believes he or she is entitled to the most detailed that he or she is willing to accept” entered, so that examination can proceed
3. SPE Abdi then promised that examination would commence in conformance with the MPEP and other applicable procedural law. Applicant acknowledged that the Examiner’s next paper might well be a restriction requirement among the 100-or-so claims entered as a result of step 2, and agreed to elect *so long as* that restriction requirement fully complies with the law.

Examiner Maguire expressed her reservations at examining a large number of claims. Applicant’s attorney asked if Examiner Maguire’s concerns would be adequately covered by the MPEP rules for restriction, which exist precisely to address workload issues. Applicant’s Attorney does not now (in October 2009) recall Examiner Maguire’s answer to the question, but assumes that any answer would be consistent with part 3 of the agreement, that the written law will control. Applicant specifically drew Examiner Maguire’s and SPE Abdi’s attention to the President’s *Final Bulletin on Agency Good Guidance Practices*,¹⁶ and requested that it be followed. No specific agreement was reached on this point, but one assumes that the PTO acknowledges that all its personnel are bound by instructions issued to agencies by the President.

¹⁶ Executive Office of the President, *Final Bulletin for Agency Good Guidance Practices*, OMB Memorandum M-07-07, <http://www.whitehouse.gov/omb/memoranda/fy2007/m07-07.pdf> (Jan. 18, 2007), 72 Fed. Reg. 3432 (Jan. 25, 2007) § II(1)(b) (“Agency employees should not depart from significant guidance documents without appropriate justification and supervisory concurrence.”).

Applicant suggested that the above three-step agreement would be clearest if Examiner Maguire sent a proposed interview summary by email so that the full agreement could be documented; Examiner Maguire declined this suggestion.

Each step of SPE Abdi's 3-step suggestion is documented in contemporaneous papers.

Steps 1 and 2 are documented in this paragraph of Examiner Maguire's interview summary:

Applicant will submit an amendment in the future reinstating original claim 14, now cancelled, and then will file an amendment directly afterwards that will include amendments to the reinstated claims, with underlines and square brackets, to clearly indicate the newly amended material.

Step 3 is documented in this paragraph of Examiner Maguire's interview summary:

Applicant stated that if new claim 190 were accepted, then he could live with a restriction of all of the other claims in reference to claim 190, and would file a divisional for the other claims in the future, if needed.

as clarified by this paragraph of Applicant's Supplementary Interview Summary filed February 27, 2009:

Applicant's attorney accepted that there is no procedural bar against restriction at this point, and that the rules do permit the Examiner to issue restriction requirements, but only so long as that restriction requirement complies fully with all requirements set forth in the MPEP and with all other applicable law. The statement reflected in the Examiner's Interview Summary should not be taken as Applicant's consent to a restriction that is not fully supported by law and the facts. Applicant does not waive any right or protection of any law, or authorize deviation from the requirements of law.

And in this statement in the Supplementary Amendment of January 23, 2009:

Applicant files this Supplementary Amendment under an agreement reached in a telephone interview of January 22, 2009.

It is believed that this paper occasions no fee. For the entire pendency of this application, the Commissioner is authorized to charge any additional required fees (including all extension of time fees), or credit any overpayment, to Deposit Account No. 50-3938, Order No. 00-8201.

Respectfully submitted,

HELIX FINANCIAL SYSTEMS, L.P.

Dated: January 6, 2010

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